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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,780	12/31/2001	Farhad Zarinetchi	102619-186	6212
21125	7590	06/21/2004	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604				SCHAETZLE, KENNEDY
				ART UNIT
				PAPER NUMBER
				3762

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/036,780	ZARINETCHI ET AL.	
	<b>Examiner</b> Kennedy Schaetzle	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 31-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 31-50 is/are rejected.
- 7) Claim(s) 51-59 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 December 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/31/01</u> .	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Specification***

1. The disclosure is objected to because of the following informalities: the applications referred to on page 1 and 11 of the specification must be updated to reflect their current status.

Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 31-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,324,430. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are merely broader versions of the patented claims. Once the applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent for the generic or broader invention (see *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)). Specifically regarding claim 31, the only difference between said claim and that of the '430 patent lies in the recitation "a compliant cushion [...] releasably mated to the primary coil." Regarding the compliant cushion limitation, patented claim 15 refers to the shield as being flexible and conformable. A flexible and conformable shield is considered to be a

compliant cushion. Regarding the recitation that the cushion is disposed on a side of the primary coil facing the secondary coil, since there is no fixed relationship between the primary and secondary coils, whether the cushion faces the secondary coil or not simply depends upon how one is holding the primary coil. Regarding the feature that the cushion is releasably mated to the primary coil, the courts have long determined that making an item separable is to be considered obvious (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)). Similar comments apply to claims with related limitations.

4. Claims 31-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 17-45 of U.S. Patent No. 6,389,318. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are merely broader versions of the patented claims. Once the applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent for the generic or broader invention (see *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)). Specifically regarding claim 31, the only difference between said claim and that of the '318 patent lies in the recitation "a compliant cushion [...] releasably mated to the primary coil." Regarding the compliant cushion limitation, the examiner considers the magnetic shield composed of porous flexible material to constitute a compliant cushion. Regarding the recitation that the cushion is disposed on a side of the primary coil facing the secondary coil, since there is no fixed relationship between the primary and secondary coils, whether the cushion faces the secondary coil or not simply depends upon how one is holding the primary coil. Regarding the feature that the cushion is releasably mated to the primary coil, the courts have long determined that making an item separable is to be considered obvious (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)). Similar comments apply to claims with related limitations. Note also claim 17 of the '318 patent which is narrower in scope by the addition of a recitation of a magnetic shield –all other elements being identical to current claim 31.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 31, 32, 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mann et al. (Pat. No. 5,545,191).

Regarding claim 31, Mann et al. disclose an external energy transfer unit 15 inductively coupled to an implanted unit 12 for transferring energy to a subcutaneous utilization device. The examiner considers it inherent that the inductively coupled devices comprise a coil in each unit, with the external coil being arbitrarily designated a primary coil, and the implanted coil being arbitrarily designated a secondary coil. In any event, the examiner takes Official Notice that it is old and well known for inductively coupled energy transfer devices to comprise an external coil and an implanted coil for receiving the transmitted energy, with the transmitting coil traditionally being referred to as the primary coil, and the receiving coil traditionally being referred to as the secondary coil.

Regarding the compliant cushion, Mann et al. disclose such an element 24 disposed on a side of the primary coil facing the secondary coil, with the cushion releasably mated to the primary coil via the use of a hook and loop type connector. By definition, a cushion in its broadest reasonable sense can be described as "...anything that provides comfort," (Webster's New World Dictionary, 3<sup>rd</sup> College Edition, 1988). As

stated in col. 4, lines 14-17, pad 24 is extended to prevent skin irritation. The examiner further considers the connector with its loop structure to inherently be soft and compliant and thus capable of absorbing force.

Regarding claim 34, the examiner considers the cushion ventilated by virtue of the fact that air can pass between the fibers of the loop material.

Substantially similar comments apply to related claims 43, 44 and 46.

### ***Claim Rejections - 35 USC § 103***

8. Claims 31, 33-37, 39-41, 43, 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brownlee et al. (Pat. No. 4,134,408) in view of Raburn et al. (Pat. No. 5,007,124).

Brownlee et al. disclose a transcutaneous energy transfer device comprising an external primary coil L1 to which energy to be transferred is applied, and an implanted secondary coil L2 configured to be inductively coupled to the primary coil and connected to apply energy to a subcutaneous utilization device (the pacer). Although Brownlee et al. do not explicitly refer to a compliant cushion releasably mated to the primary coil, they do teach that the coil 54 may be mounted in a bed 56. Artisan Raburn et al. disclose a resilient crenellated foam cushion useful in medical settings such as hospitals, homes and convalescent centers. Raburn et al. teach that the cushion allows for proper ventilation of the underside of patients, improves patient comfort, and carries away perspiration, thus aiding in preventing bed sores and speeding wound recovery. Those of ordinary skill in the medical arts desiring to enhance the comfort and speed the healing of a pacemaker implant patient, would have seen the obviousness of adding such a releasable cushion to the bed/coil embodiment discussed by Brownlee et al..

Regarding the use of open cell foam, the courts have long established that the use of a known material based on its suitability for the intended purpose, is obvious (see *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945)). Since open cell foam is well known to provide cushioning and body support, its incorporation into the cushion of Raburn et al. would have been considered a matter of obvious design by those of ordinary skill in the art.

Regarding claim 37, it is considered blatantly obvious that a bed cushion for a patient must be non-allergenic and non-irritating to the skin.

9. Claims 31, 33, 34, 36-38, 39-41, 43, 45, 46 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brownlee et al. in view of Raburn et al. (Pat. No. 5,459,896).

The application of Raburn et al. '896 to Brownlee et al. '408 substantially parallels the application of Raburn et al. '124 to Brownlee et al. '408. It is repeated that those of ordinary skill in the medical arts desiring to enhance the comfort and speed the healing of a pacemaker implant patient, would have seen the obviousness of adding such a releasable cushion to the bed/coil embodiment discussed by Brownlee et al..

Regarding claims directed to the use of a skin-compatible material bonded to the foam layer, Raburn '896 further teaches that foam cushions such as those used on beds, may further comprise an additional layer of elastic water resistant material in order to protect the underlying foam layer (see Fig. 10).

#### ***Allowable Subject Matter***

10. Claims 51-59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There does not appear to be a teaching in the prior art of record for modifying the applied references to include a magnetic shield covering the opposed side of the primary coil.

#### ***Information Disclosure Statement***

11. The documents relating to transcripts listed on page 4 of the IDS received December 31, 2001 could not be considered because the examiner has no way of obtaining this information as copies of the documents are absent the parent case filewrappers and no scans of the documents are available to the examiner in IFW.

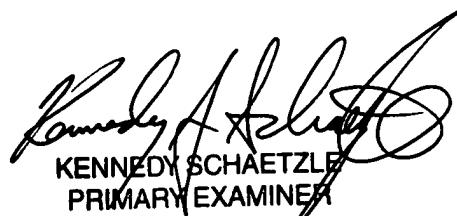
***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 703 308-2211. The examiner can normally be reached on 9:30 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-0851. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KJS  
June 17, 2004



KENNEDY SCHAETZLE  
PRIMARY EXAMINER